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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,521	10/27/2003	Dirk Luthardt	01048	9479
7590	11/12/2004		EXAMINER	
Walter Ottesen Patent Attorney P.O. Box 4026 Gaithersburg, MD 20885-4026			NGUYEN, THONG Q	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/693,521	Applicant(s) LUTHARDT ET AL.	
	Examiner Thong Q Nguyen	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-13 is/are rejected.
- 7) ☒ Claim(s) 1-5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/27/03; 12/1/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species (I) as shown in figure 2 in the reply filed on 10/15/2004 is acknowledged. However, a careful search of the device as claimed in present claim 6 has resulted that the device claimed in claim 6 is patentable with respect to the prior art, and thus claim 13 is now rejoined by the Examiner and also examine in this Office action.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 4/27/2001 and the PCT filed in Europe on 4/25/02. It is noted, however, that applicant has not filed a certified copy of the mentioned applications as required by 35 U.S.C. 119(b).

Drawings

3. The drawings contain three sheets of figures 1-3 were received on 10/27/2003. These drawings are objected by the Examiner for the following reason(s).

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: In particular, the numerical reference "21" as shown in figure 2 is not mentioned in the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet

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should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature related to the tensioning device as claimed in claim 11 (see the present specification in page 8, lines 22-24), must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of

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the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

7. The disclosure is objected to because of the following informalities: a) In page 2: line 2, the term "Spectiv" is a typo; b) In page 7: line 7, "27" should be changed to --37-- because the output shaft of the coarse drive is labeled as "37" in page 6 (lines 24, 25, 28, etc...) and the numerical reference "27" is used for the belt of the fine drive in page 7, line 15. There are still some grammatical and idiomatic errors in the specification. Applicant should carefully proofread the specification. Appropriate correction is required.

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not provide a proper antecedent basis for the subject recited in each of claims 9 and 12.

In particular, the specification does not positively disclose that the coarse and fine actuating elements are offset with respect to the optical axis of the focus optic as claimed in claim 9; and the specification does not disclose the feature

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that the "positioning of said focus optic which is more precise by a factor of three" as recited in claim 12.

Regarding to the feature recited in claim 12 as mentioned above, it is noted that in page 5, lines 4-8, the specification has stated: "As a suitable matching...coarse and fine drives". However, the information disclosed in the mentioned paragraph is directed to the movement of the focus optic caused by a coarse drive system in compare to the movement of the focus optic caused by the fine driving system. The information as provided in the mentioned phrase does not guarantee or disclose that the position of the focus optic is more precise by a factor of three as claimed in claim 12.

Claim Objections

9. Claims 4 and 6 are objected to because of the following informalities.

Appropriate correction is required.

- a) In claim 4: on line 5, --unit—should be added after "drive" because the base claim 1 recites a fine drive unit (see claim 1, line 8);
- b) In claim 6: on line 8, "second" should be changed to —fine—because the claim and its base claim have never recited a shaft labeled as "second". Further, claim 6 recites that the fine drive unit comprises a fine output shaft as can be seen on lines 1-3 of the claim.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Leica Company brochure submitted by applicant in view of Kashiba et al (Japanese reference No. 2-3003).

The Leica Company brochure discloses a telescope having a mechanism for moving a lens system for focusing. The mechanism disclosed in the mentioned brochure as described in page 2 of the present specification comprises a coarse drive and a fine drive for focusing. An actuating element of the coarse drive is connected to the output shaft wherein a rotational movement of the output shaft is transmitted to a spindle via a toothed belt. An actuating element of the fine drive is connected to the output shaft via a drag gear. The use of two actuating elements for coarse and fine focusing mounted on the frame of the telescope and spaced relationship to each other is shown in the figure on the front page of the brochure. It is noted that the Leica company brochure does not disclose the use of a fine drive system having a belt for driving the output shaft during a fine focusing process.

However, the use of a mechanism for fine focusing process wherein the mechanism comprises a belt drive is known to one skilled in the art as can be seen in the telescope provided by Kashiba et al. In particular, Kashiba et al disclose a mechanism comprises a coarse focusing mechanism and a fine focusing mechanism wherein the fine focusing mechanism comprises a belt and

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pulleys which mechanism has a larger reduction ratio than that of the coarse focusing mechanism. See pages 2-3 and figures 1-2 and the English abstract. Regarding to the feature that the position of the focusing optic is more precise by a factor of three in a the fine focusing then that provided by the coarse focusing as recited in present claim 12, such a feature is an obvious matter within the level of one skilled in the art in the process of adjustment the ratio between the two focusing mechanism for meeting a particular design. See *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980); *In re Aller*, 105 USPQ 233. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the telescope having a coarse focusing mechanism and a fine focusing mechanism as disclosed in the Leica Company brochure by using a fine mechanism having a drive belt as suggested by Kashiba et al for the purpose of preventing the backlash and the providing a precise operation of the system over time.

Allowable Subject Matter

12. Claims 6-11 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: The device as claimed in claim 6 is patentable with respect to the prior art by the limitations related to the fine drive unit for fine focusing wherein the fine focus unit comprises a fine output shaft, fine directional-changing roller and the connection

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between the fine actuating element and the fine output shaft. It is noted that a mechanism for coarse and fine focus adjustment having a coarse focus adjustment system having knob, coarse output shaft and gear train and a fine focus adjustment system having knob, fine output shaft and gear train is known to one skilled in the art as can be seen in the Patent Nos. 4,482,221; 3,683,704; 4,083,256 and 5,793,526; however, the prior art does not disclose that the coarse and fine focus systems each comprises a drive belt unit for driving the coarse and fine output shafts.

Conclusion

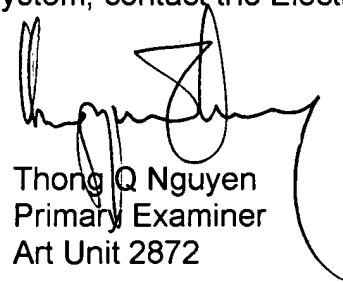
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen
Primary Examiner
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